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PATENT APPLICATION
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OCT 25 2004
OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Markku VERKAMA et al.

Art Unit: 2663

Application No.: 09/510,893

Examiner: Min JUNG

Filed: February 23, 2000

Attorney Dkt. No.: 59643.00087

For: MANAGEMENT OF PACKET SWITCHED CONNECTIONS IN A MOBILE COMMUNICATIONS NETWORK

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.182

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 20, 2004

Sir:

On October 17, 2003, Applicants submitted a petition under 37 C.F.R. §1.182 to substitute the current Specification of the above-captioned U.S. Patent Application (a U.S. Continuation Application) with a new Specification that is an English-language translation of the Finnish-language Specification of the PCT Application (PCT/FI99/00564) which is the parent of the above-captioned U.S. Continuation Application.

On September 1, 2004, Applicants received a Decision on Petition regarding the above mentioned petition under 37 C.F.R. §1.182. The Decision stated that 37 C.F.R. §1.182 provides a manner by which practitioners may petition the Commissioner for all situations which are not specifically provided otherwise provided for in the regulations. Whereas, 37

C.F.R. §1.125 provides a manner by which practitioners may have a substitute Specification entered. The Decision on Petition, therefore, dismissed the petition under 37 C.F.R. §1.182 as inappropriate.

Applicants respectfully request reconsideration of the petition under 37 C.F.R. §1.182, because a petition under 37 C.F.R. §1.125 would not be appropriate in this case. 37 C.F.R. §1.125(b) states that a substitute specification may be filed at any point up to the payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter. As will be discussed below, the new Specification, which is an English-language translation of the Finnish-language Specification of the PCT Application (PCT/FI99/00564), is not submitted as a substitute specification but is instead submitted to correct an error introduced during the PCT International Phase. For this reason, Applicants respectfully submit that the petition under 37 C.F.R. §1.182 was indeed appropriate, since 37 C.F.R. §1.125 does not apply in this situation. Given the facts of this case, it is respectfully submitted that Applicants cannot seek relief under 37 C.F.R. §1.125. Therefore, Applicants respectfully request reconsideration of the petition under 37 C.F.R. §1.182.

A copy of the petition as filed on October 17, 2004 and a copy of a Declaration that details the circumstances surrounding the filing of the Petition is attached hereto. Also attached is a copy of a true and verified Translation of the Finnish-language PCT Application.

Enclosed is a check in the amount of One Hundred Thirty Dollars (\$130.00) to cover the cost of the petition fee. In the event that this check is found to be insufficient, or if any

additional fees are due with respect to the filing of this paper, please charge Counsel's
Deposit Account Number 50-2222.

Respectfully submitted,



Majid S. Albassam
Registration No. 54,749

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

Enclosures: Check No. 12078 in the amount of One Hundred Thirty Dollars (\$130.00)
Petition under 37 C.F.R. § 1.182
Declaration Supporting Petition Under 37 C.F.R. § 1.182
Verified Translation



COPY

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Markku VERKAMA et al.

Art Unit: 2663

Application No.: 09/510,893

Examiner: Min JUNG

Filed: February 23, 2000

Attorney Dkt. No.: 59643.00087

For: MANAGEMENT OF PACKET SWITCHED CONNECTIONS IN A MOBILE
COMMUNICATIONS NETWORK

RECEIVED
OCT 25 2004
OFFICE OF PETITIONS

PETITION UNDER 37 C.F.R. § 1.182

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 17, 2003

Sir:

Applicants petition under 37 C.F.R. §1.182 to substitute the current Specification of the above-captioned U.S. Patent Application (a U.S. Continuation Application) with a new Specification that is an English-language translation of the Finnish-language Specification of the PCT Application (PCT/FI99/00564) which is the parent of the above-captioned U.S. Continuation Application. An explanation of why this Petition has been filed is provided below, along with reasons why this Petition should be granted.

A Declaration that details the circumstances surrounding the filing of the present Petition is attached hereto. Also attached are a true and verified Translation of the Finnish-

language PCT Application and a check in an amount equal to the fee for the filing of this Petition.

Background

As discussed in the attached Declaration by Ms. Sirpa Kuisma, a European Patent Attorney who is fluent in both Finnish and English, Applicants have filed the present Petition because, after comparing the Specification of the above-captioned U.S. Continuation Application with the above-referenced Finnish-language PCT Application, Applicants discovered some inconsistency between the two documents. The Declaration also discusses why the inconsistency is present, and explains why the Specification of the true and verified Translation, attached hereto, should be substituted for the current Specification.

As detailed in the attached Declaration, Ms. Kuisma's European law firm recently took over the responsibilities of the Applications discussed herein from a previous agent of the Assignee of these Applications. When reviewing the file of the PCT application, Ms. Kuisma discovered that the previous agent had filed a Finnish Application (FI981485) on June 26, 1998. Ms. Kuisma also discovered that, on June 24, 1999, the previous agent had filed a PCT Application, in Finnish, in the Finnish Patent Office acting as the Receiving Office, claiming priority from the Finnish Patent Application. Ms. Kuisma then discovered that the previous agent had filed an English translation of the PCT Application in the Swedish Patent Office acting as the International Search Authority on August 26, 1999.

When Ms. Kuisma compared the English translation filed with the Swedish Patent Office and the Finnish-language PCT Application, she found that the subject matter contained in these two documents was not identical. Rather, the subject matter in the English

translation corresponded to the subject matter previously contained in the Finnish Patent Application, rather than the PCT Application.

As explained in the attached Declaration, it appears as though the translator who prepared the English translation filed on August 26, 1999 had not been made aware by the previous agent that the Finnish Patent Application was not identical to the Finnish-language PCT Application. Hence, the translator prepared a translation of the Finnish Patent Application rather than of the PCT Application. This has resulted in the current Specification of the above-captioned U.S. Continuation Application being inconsistent with the Specification of the PCT Application.

In order to correct this situation, Ms. Kuisma, a European Patent Attorney who is, as mentioned above, fluent in both English and Finnish, has prepared and verified the Translation attached hereto. The attached Translation is of the Finnish-language PCT Application discussed above, and not of the Finnish Patent Application. Applicants request that the attached Translation be entered as a Substitute Specification in the above-captioned U.S. Continuation Application.

Reasons for Granting the Present Petition

Applicants respectfully submit that the present Petition should be granted. In other words, Applicants respectfully submit that they should be allowed to substitute the Specification included in the Translation attached hereto for the current Specification of the above-captioned U.S. Continuation Application. Reasons for granting this Petition are provided below.

First, Applicants respectfully submit that it is clear from the prosecution history of the U.S. Continuation Application that it was Applicants' intent to file a translation of the Finnish-language PCT Application, not of the Finnish Patent Application, in the U.S. This intent is particularly clear in view of the fact that, on February 23, 2000, a Request for Continuation of an International Application Under 37 C.F.R. §1.53(b) had been filed with the U.S. Patent Office, listing PCT/FI99/00564, rather than the Finnish Patent Application, as the parent Application.

Next, Applicants respectfully submit that the filing of a translation of the wrong document was purely the result of a clerical error, having no deceptive intent associated therewith. As discussed in the attached Declaration, and as shown in the attached Translation, only a small portion of the text in the Finnish Patent Application was modified to generate the Finnish-language PCT Application. Therefore, an administrative oversight by Applicants' previous agent explains why an error was made. Applicants point out, however, that upon having discovered the error, Applicants' current representatives have acted diligently in attempting to correct it.

In addition to the above, Applicants point out that the Finnish-language PCT Application was filed with the Finnish Patent Office, an internationally-recognized entity that granted Applicants an internationally-recognized filing date. Further, Applicants point out that public access to the Finnish-language PCT Application is available at the International Bureau under PCT Rule 94.1(b). Hence, a verifiable and credible record exists of what subject matter Applicants originally attempted to protect in the PCT Application and of when protection for this subject matter was first sought. Therefore, Applicants respectfully submit

that they are not presently attempting to add subject matter that was not previously disclosed in the documents upon which the present U.S. Continuation Application claims priority. Rather, Applicants are merely attempting to incorporate subject matter into the present U.S. Continuation Application that should have been included therein from the outset.

Lastly, Applicants point out that, under 35 U.S.C. §371(c), "[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office". At least in view of this section of the Code, Applicants respectfully submit that, in the case at hand, the above-discussed Finnish-language PCT Application effectively became the U.S. Continuation Application. Hence, correcting the Specification of the U.S. Continuation Application using the attached Translation does not constitute the addition of new matter. Rather, the subject matter being added as part of the correction has been a part of the present U.S. Continuation Application from the outset, simply in a different language.

Conclusions

Applicants have supported that, from the outset, the subject matter contained in the attached Translation is what Applicants intended to file as the U.S. Continuation Application discussed herein. Applicants have also supported that the present Petition has been filed pursuant to the detection of a clerical error that involved no deceptive intent. Further, Applicants have shown that, under 35 U.S.C. §371(c), all of the information contained in the attached Translation is already part of the U.S. Continuation Application, just in a different language.

Even further, Applicants have pointed out that an internationally-recognized and highly credible entity, namely, the International Bureau, has available records supporting the fact that the attached Translation contains no subject matter that was not previously included in the Finnish-language PCT Application. Therefore, at least for the reasons discussed above, Applicants respectfully request that the present Petition be granted and that the Specification portion of the attached Translation of the Finnish-language PCT Application be substituted for the present Specification.

The filing of this petition and the supporting declaration was discussed with Mr. Paul Bell of the PCT legal office. Mr. Bell's assistance is greatly appreciated.

Enclosed is a check in the amount of one-hundred-and-thirty dollars (\$130.00) to cover the cost of the petition fee. In the event that this check is found to be insufficient, or if any additional fees are due with respect to the filing of this paper, please charge Counsel's Deposit Account Number 50-2222.

Respectfully submitted,

SIGNATURE ON ORIGINAL

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

Hermes M. Soyez, Ph.D.
Registration No. 45,852

HMS:lls

Enclosures: Check No. 010569 in the amount of \$130.00
Declaration Supporting Petition Under 37 C.F.R. § 1.182
Verified Translation



2663

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

RECEIVED

VERKAMA et al.

Group Art Unit: 2663

OCT 26 2004

Application No.: 09/510,893

Examiner: Min JUNG

Technology Center 2600

Filed: February 23, 2000

Attorney Dkt. No.: 59643.00087

For: MANAGEMENT OF PACKET SWITCHED CONNECTIONS IN A MOBILE COMMUNICATIONS NETWORK

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

October 20, 2004

Sir:

Applicant respectfully petitions that the abandonment of the above-referenced patent application be withdrawn, and prosecution reinstated. The purported abandonment, as discussed below, was apparently due to a loss or mishandling of a Response and Petition for Extension of Time which were timely filed in the United States Patent & Trademark Office on December 22, 2003.

An Official Action was mailed on June 20, 2003. A full and complete response, and an extension of time for three months, was filed on December 22, 2003, where December 20, 2003 was a Saturday. Copies of this Petition for Extension of Time, and the Response, are attached hereto.

Also attached is a copy of the PTO postcard receipt which lists all of the papers and items which were submitted with the response on December 22, 2003. This postcard is stamped "received" by the OIPE of the United States Patent & Trademark Office on December 22, 2003.

Additionally, a Request for Status was filed on July 23, 2004. Also attached is a copy of this Request for Status and the PTO postcard receipt which lists the Request for

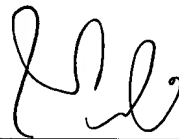
Status which was submitted on July 23, 2004. This postcard is stamped "received" by the OIPE of the United States Patent & Trademark Office on July 23, 2004.

For the Examiner's convenience, copies of all submitted papers are filed herewith.

In view of the fact that the Office Action dated June 20, 2003 was timely responded to, applicant respectfully requests that the abandonment of this application be withdrawn, prosecution reinstated, and the response of December 22, 2003, appropriately considered on the merits.

In the event that there are any fees due with respect to this paper including the petition fee, please charge Counsel's Deposit Account No. 50-2222.

Respectfully submitted,



Majid S. AlBassam
Registration No. 54,749

Customer Number 32294
SQUIRE, SANDERS & DEMPSEY LLP
8000 Towers Crescent Drive, 14th Floor
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

MSA:mmi

Enclosures: Copy of Response, Petition for Extension of Time and attachments as filed on December 22, 2003
Copy of Request for Status as filed on July 23, 2004
Copy of Stamped Postcard Receipts